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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,852	09/23/2005	Hans-Peter Buchstaller	24945-0023	7098

49442 7590 12/12/2007  
BAKER & DANIELS LLP  
805 15TH STREET, NW, SUITE 700  
WASHINGTON, DC 20005

EXAMINER

CHU, YONG LIANG

ART UNIT	PAPER NUMBER
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1626

MAIL DATE	DELIVERY MODE
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12/12/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/549,852	<b>Applicant(s)</b> BUCHSTALLER ET AL.	
	<b>Examiner</b> Yong Chu	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 1-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

Claims 34-37 are new by Amendment filed on 10/16/2007. The remaining subject matter of Claims 1-32 (excluded from new claims 34-37) is remained withdrawn. Therefore, claims 34-37 will be examined on the merits.

### ***Response to Amendment***

The Amendment by Applicants' representative Ronald J. Kamis dated on 10/16/2007 has been entered.

### ***Response to Arguments/Amendment***

#### **Objection to the Specification**

Applicant has added the priority information to the first paragraph of the application. Therefore, the objection is withdrawn.

#### **Rejection under 35 U.S.C. §112, 2<sup>nd</sup> paragraph**

Applicant's amendments of claim 33 obviated the original rejection. However, the amendment causes a new rejection; see later section of this Office action.

#### **Rejection under 35 U.S.C. §102(b)**

Applicant amended claim 33 by further limiting the **Ar<sup>2</sup>** as a pyridinyl residue, which is bonded to **X** in the 3- or 4- position relative to the pyridinyl residue. This amendment overcomes the original rejection.

**Rejection under obviousness-type double patenting**

Since Applicant did not argue the ODP rejection, the rejection is maintained.

**Claim objection**

The objection is moot, because the search and examination have been expanded.

The new rejection based on amended claim 33 and new claims 34-37:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 33-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "pyridinyl derivative" renders claim 33 indefinite. By definition, "derivative" is defined as a compound derived or obtained from another and containing essential elements of the parent substance. It is not clear which compound is included or excluded from these claims, because the specification does not define which element of the "pyridinyl derivative" is essential, and what are the essential elements.

The remaining claims are rejected for depending from an indefinite claim.

Claims 33-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "ONC<sub>3</sub>H<sub>2</sub>" in the so called "heteroatoms" renders claim 33 indefinite, because "ONC<sub>3</sub>H<sub>2</sub>" is not a heteroatom, and also it is not defined as a specific formula, which renders the Formula (II) unclear which compound is included or excluded.

The remaining claims are rejected for depending from an indefinite claim 33.

### ***Claim Rejections - 35 USC § 102***

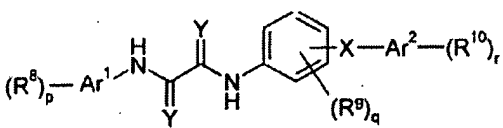
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

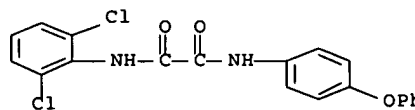
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 33-37 are rejected under 35 U.S.C. 102 (b) as being anticipated by Boger et al., *U.S. Patent No. 4,656,183* ("the '183 patent").

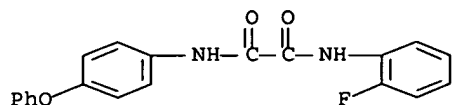
Applicants instant elected invention in claims 33-37 relates to compounds of

formula II  , depicted in claim 33, wherein Y is O, and the remaining substituents are defined as in claim 33.

The '183 patent teaches specific compounds



(CAS RN 98500-12-0, as Compound 22, see columns 15-16) , and



(CAS RN 98500-20-0, as Compound 31, see

columns 17-18), which anticipate the instantly claimed genus.

### ***Conclusion***

- Claims 33-37 are rejected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

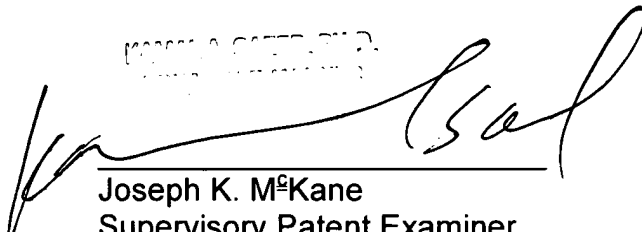
***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
\_\_\_\_\_  
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